

ESTTA Tracking number: **ESTTA426639**Filing date: **08/23/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

|                                       |   |
|---------------------------------------|---|
| Name                                  | Clark Capital Management Group, Inc.  |
| Granted to Date of previous extension | 08/24/2011  |
| Address                               | One Liberty Place, 53 Floor 1650 Market Street<br>Philadelphia, PA 19103<br>UNITED STATES                                     |
| Attorney information                  | Camille M. Miller<br>Cozen O'Connor, PC<br>1900 Market Street<br>Philadelphia, PA 19103<br>UNITED STATES<br>cmiller@cozen.com |

**Applicant Information**

|                        |  |                        |            |
|------------------------|--|------------------------|------------|
| Application No         | 85193740   | Publication date       | 04/26/2011 |
| Opposition Filing Date | 08/23/2011   | Opposition Period Ends | 08/24/2011 |
| Applicant              | Serenic Software, Inc<br>7175 West Jefferson Avenue, Suite 2500<br>Lakewood, CO 80235<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

Class 009. First Use: 2003/06/30 First Use In Commerce: 2003/06/30  
All goods and services in the class are opposed, namely: Accounting software for financial management and business operations management for use by nonprofit and public sector institutions


**Grounds for Opposition**


|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

**Marks Cited by Opposer as Basis for Opposition**




|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1662756    | Application Date      | 09/21/1990 |
| Registration Date     | 10/29/1991 | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR  |                       |            |
| Design Mark           |            |                       |            |
| Description of        | NONE       |                       |            |

|                |  |
|----------------|--|
| Mark           |  |
| Goods/Services | Class 036. First use: First Use: 1987/03/10 First Use In Commerce: 1987/03/10 investment advisory services in the field of stocks and mutual funds |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2789230   | Application Date      | 01/30/2001 |
| Registration Date     | 12/02/2003  | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATORLINK   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 009. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 computer software and programs for use in database management<br>Class 036. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 financial and investment advisory services in the field of stocks and mutual funds |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2750916  | Application Date      | 01/18/2001 |
| Registration Date     | 08/12/2003   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR ASSET MANAGEMENT   |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 2001/04/15 First Use In Commerce: 2001/04/15 financial and investment advisory services in the field of stocks and mutual funds |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2638519   | Application Date      | 01/10/2001 |
| Registration Date     | 10/22/2002  | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR PREMIER   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 036. First use: First Use: 1999/01/01 First Use In Commerce: 1999/01/01 |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
|                       | investment advisory services in the field of stocks and mutual funds   |                       |            |
| U.S. Registration No. | 3292265  | Application Date      | 06/08/2006 |
| Registration Date     | 09/11/2007   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR SENTRY   |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 2003/01/01 First Use In Commerce: 2003/01/01 investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services |                       |            |
| U.S. Registration No. | 2324236  | Application Date      | 03/12/1999 |
| Registration Date     | 02/29/2000   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR STRATEGIC WORLD  |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 1997/01/14 First Use In Commerce: 1997/01/14 investment management services for optimal asset allocation in the field of stocks, bonds and mutual funds   |                       |            |
| U.S. Registration No. | 2318330  | Application Date      | 08/28/1998 |
| Registration Date     | 02/15/2000   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR CLASSIC  |                       |            |
| Design Mark           |    |                       |            |

|                     |  |
|---------------------|--|
| Description of Mark | NONE   |
| Goods/Services      | Class 036. First use: First Use: 1994/01/00 First Use In Commerce: 1994/01/00 INVESTMENT ADVISORY SERVICES IN THE FIELD OF STOCKS AND MUTUAL FUNDS |


|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2639961  | Application Date      | 06/10/1998 |
| Registration Date     | 10/22/2002   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR FUND   |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 2002/04/01 First Use In Commerce: 2002/04/01 INVESTMENT ADVISORY SERVICES IN THE FIELD OF STOCKS AND MUTUAL FUNDS |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1904627  | Application Date      | 05/31/1994 |
| Registration Date     | 07/11/1995   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR S.T.A.R.   |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 1994/01/00 First Use In Commerce: 1994/01/00 investment advisory services in the field of stocks and mutual funds |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1849587  | Application Date      | 03/02/1993 |
| Registration Date     | 08/09/1994   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR MASTER   |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 1994/01/00 First Use In Commerce: 1994/01/00 investment advisory services in the field of stocks and mutual funds |                       |            |


|                       |                |                       |            |
|-----------------------|----------------|-----------------------|------------|
| U.S. Registration No. | 3426152        | Application Date      | 08/27/2007 |
| Registration Date     | 05/13/2008     | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR 401K |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         | NAVIGATOR 401K   |
| Description of Mark | NONE   |
| Goods/Services      | Class 036. First use: First Use: 2007/02/00 First Use In Commerce: 2007/02/00 investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3608683   | Application Date      | 09/12/2008 |
| Registration Date     | 04/21/2009  | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR   |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 016. First use: First Use: 2006/01/02 First Use In Commerce: 2006/01/02 printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services<br>Class 036. First use: First Use: 2006/01/02 First Use In Commerce: 2006/01/02 investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services |                       |            |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3698185    | Application Date      | 03/04/2009 |
| Registration Date     | 10/20/2009 | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR  |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         | NAVIGATOR   |
| Description of Mark | NONE  |
| Goods/Services      | Class 016. First use: First Use: 1987/03/10 First Use In Commerce: 1987/03/10 printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services<br>Class 036. First use: First Use: 1987/03/10 First Use In Commerce: 1987/03/10 investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3721660  | Application Date      | 05/07/2009 |
| Registration Date     | 12/08/2009   | Foreign Priority Date | NONE       |
| Word Mark             | NAVIGATOR 401(K) "KEEPING YOU ON COURSE FOR RETIREMENT"  |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | The mark consists of compass design.   |                       |            |
| Goods/Services        | Class 036. First use: First Use: 2007/02/00 First Use In Commerce: 2007/02/00 investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services |                       |            |

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|-------------|--|
| Attachments | 76202022#TMSN.gif ( 1 page )( bytes )<br>76195532#TMSN.gif ( 1 page )( bytes )<br>78903791#TMSN.jpeg ( 1 page )( bytes )<br>75659523#TMSN.gif ( 1 page )( bytes )<br>75546330#TMSN.gif ( 1 page )( bytes )<br>77265235#TMSN.jpeg ( 1 page )( bytes ) |
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|  | 77568943#TMSN.jpeg ( 1 page )( bytes )<br>77683006#TMSN.jpeg ( 1 page )( bytes )<br>77731249#TMSN.jpeg ( 1 page )( bytes )<br>PHILADELPHIA-<br>#6162865-v3-Notice_of_Opposition_SERENIC_NAVIGATOR.pdf ( 8 pages<br>)(45308 bytes ) |
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                     |
|-----------|---------------------|
| Signature | /Camille M. Miller/ |
| Name      | Camille M. Miller   |
| Date      | 08/23/2011          |

|   |            |                           |
|---|------------|---------------------------|
| CLARK CAPITAL MANAGEMENT<br>GROUP, INC. | Opposer,   | Opposition No.            |
| v.                                      |            | Serial No. 85/193,740     |
|   |            | Filed: December 8, 2010   |
|   |            | Published: April 26, 2011 |
| SERENIC SOFTWARE, INC.                  |            | Mark: NAVIGATOR           |
|   | Applicant. |                           |

Clark Capital Management Group, Inc., a Pennsylvania corporation, with a place of business at One Liberty Place, 1650 Market Street, 53rd Floor, Philadelphia, PA 19103 (“Opposer”), believes that it will be damaged by registration of the mark NAVIGATOR, which is the subject of application Serial No. 85/193,740, published in the April 26, 2011 *Official Gazette*, and hereby opposes the same.

1. Upon information and belief, Applicant, Serenic Software, Inc. (“Applicant”) is a Delaware corporation, with its principal address located at 7175 West Jefferson Avenue, Suite 2500, Lakewood, CO, 80235.

2. Upon information and belief, Applicant filed an application to register the mark NAVIGATOR for “accounting software for financial management and business operations management for use by nonprofit and public sector institutions.” in International Class 9, on December 8, 2010.



3. Applicant's mark published in the Official Gazette on April 26, 2011. Opposer filed a ninety-day request for extension of time on April 26, 2011, thereby granting Opposer until August 24, 2011 to file its Notice of Opposition.

4. On September 21, 1990, Opposer filed an application for registration of the mark NAVIGATOR in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 74/099,288 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds." The date of first use is at least as early as March 10, 1987. This application was allowed by the Patent and Trademark Office and issued as Registration No. 1,662,756 on October 29, 1991.

5. On January 31, 2001, Opposer filed an application for registration of the mark NAVIGATORLINK in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 76/202,022 and covers the use of this mark in conjunction with "computer software and programs for use in database management" and "financial and investment advisory services in the field of stocks and mutual funds." The date of first use is at least as early as January 1, 2000. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,789,230 on December 2, 2003.

6. On January 18, 2001, Opposer filed an application for registration of the mark NAVIGATOR ASSET MANAGEMENT in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 76/195,532 and covers the use of this mark in conjunction with "financial and investment advisory services in the field of stocks and mutual funds." The date

of first use is at least as early as April 15, 2004. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,750,916 on August 12, 2003.

7. On January 10, 2001, Opposer filed an application for registration of the mark NAVIGATOR PREMIER in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 76/192,050 and covers the use of this mark in conjunction with “investment advisory services in the field of stocks and mutual funds.” The date of first use is at least as early as January 1, 1999. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,638,519 on October 22, 2002.

8. On September 11, 2007, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,292,265 for NAVIGATOR SENTRY for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; and stock brokerage services. Opposer used this mark as early as January 2003.

9. On March 12, 1999, Opposer filed an application for registration of the mark NAVIGATOR STRATEGIC WORLD in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 75/659,523 and covers the use of this mark in conjunction with “investment management services for optimal asset allocation in the field of stocks, bonds and mutual funds.” The date of first use is at least as early as January 14, 1997. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,324,236 on February 29, 2000.

10. On August 28, 1998, Opposer filed an application for registration of the mark NAVIGATOR CLASSIC in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 75546330 and covers the use of this mark in conjunction with “investment advisory services in the field of stocks and mutual funds.” The date of first use is at least as early as January 1, 1994. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,318,330 on February 15, 2000.

11. On June 10, 1998, Opposer filed an application for registration of the mark NAVIGATOR FUND in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 75/499,466 and covers the use of this mark in conjunction with “investment advisory services in the field of stocks and mutual funds.” The date of first use is at least as early as March 1, 2002. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,639,961 on October 22, 2002.

12. On May 31, 1994 Opposer filed an application for registration of the mark NAVIGATOR S.T.A.R. in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 74/531,302 and covers the use of this mark in conjunction with “investment advisory services in the field of stocks and mutual funds.” The date of first use is at least as early as 1994. This application was allowed by the Patent and Trademark Office and issued as Registration No. 1,904,627 on July 11, 1995.

13. On March 2, 1993 Opposer filed an application for registration of the mark NAVIGATOR MASTER in the United States Patent and Trademark Office on the Principal

Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 74/364,257302 and covers the use of this mark in conjunction with “investment advisory services in the field of stocks and mutual funds.” The date of first use is at least as early as 1994. This application was allowed by the Patent and Trademark Office and issued as Registration No. 1,849,587 on August 9, 1994.

14. On May 13, 2008, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,426,152 for NAVIGATOR 401K for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Opposer used this mark as early as February 2007.

15. On April 21, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,608,683 for NAVIGATOR & Design for printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services; investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Opposer used this mark as early as January 2006.

16. On October 20, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,698,185 for NAVIGATOR for printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services; investment advisory services in the field of stocks, bonds,

annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Opposer used this mark as early as March 1987.

17. On December 8, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,721,660 for NAVIGATOR 401(K) "KEEPING YOU ON COURSE FOR RETIREMENT" & Design for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Opposer used this mark as early as February 2007.

18. On July 27, 2001, Opposer filed a lawsuit against Applicant in the United States District Court for the Eastern District of Pennsylvania, charging applicant with trademark infringement, unfair competition, and unjust enrichment, in connection with its use of the NAVIGATOR mark, Case No: 2011CV04752 (the "Federal Action").

19. Opposer will file a request to suspend these proceedings pending final disposition of the Federal Action.

#### **LIKELIHOOD OF CONFUSION PURSUANT TO SECTION 2(D)**

20. Opposer's family of NAVIGATOR marks and Applicant's NAVIGATOR mark are identical with respect to some of the marks and very similar with respect to other marks in sound, appearance, and meaning. The marks create the same commercial impression and are confusingly similar.

19. Upon information and belief, the channels of trade of both Opposer's goods and services and Applicant's goods are closely related.

20. Upon information and belief, the customer base of both Opposer's goods and services and Applicant's goods are similar, if not identical.

22. Registration of the mark NAVIGATOR by Applicant on the Principal Register would restrict and impair Opposer's right to use, develop and expand its use of its family of NAVIGATOR marks, and would otherwise cause injury and damage to Opposer's NAVIGATOR marks, as well as its good will and reputation.

23. If Applicant is permitted to register its mark, and, thereby, obtain the *prima facie* exclusive right to use the mark NAVIGATOR in commerce, confusion is likely to result, and Opposer will be damaged thereby.

24. WHEREFORE, Opposer prays that allowance of Serial No. 85/193,740 be refused and that this Opposition be sustained.

Respectfully submitted,



Date: 8/23/2011

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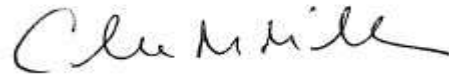
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David M. Albert, Esq.  
COZEN O'CONNOR, P.C.  
1900 Market Street  
Philadelphia, Pennsylvania 19103  
Telephone: (215) 665-7273  
Facsimile: (215) 665-2273

Attorneys for Opposer

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing document was electronically filed with the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board on August 23, 2011, was e-mailed to the Opposer on August 23, 2011, and will be mailed on August 23, 2011 via First Class Mail, postage prepaid to Opposer at the following address:

Mr. Jeffrey F. Craft  
Law Office of Jeffrey Craft  
2069 Cold Canyon Road  
Calabasas, CA 91302-2369

A handwritten signature in black ink, appearing to read "Camille M. Miller", written in a cursive style.

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Camille M. Miller, Esquire

Date: August 23, 2011